

REMARKS

Withdrawal of the Final Rejection, entry of the foregoing amendments, and favorable reconsideration of the subject application, is respectfully requested in view of the following comments.

Upon entry of the above amendments, claims 1-4 and 10-15, will be pending in this application.

In order to materially expedite prosecution and reduce the issues remaining to be resolved, "product-by-process" claims 8 and 9 have been cancelled, although not the subject matter thereof. Applicant reserves the right to separately prosecute the subject matter of claims 8 and 9 and any other disclosed but unclaimed subject matter.

Furthermore, in order to better understand the essence of the inventive contribution made by the present inventor, the preamble of claim 1 is modified to clarify that the process of the present invention has as its main aim (in the course of producing a coffee-flavored alcoholic beverage) re-producing or re-introducing coffee flavor in an extraction residue of roasted coffee beans which is itself substantially free of coffee flavor. The re-production of coffee-flavor from the extraction residue is accomplished by subjecting the extraction residue (from which coffee flavor substances have previously been substantially removed by the extraction process) to alcoholic fermentation.

This aspect of the present invention is described in the specification (see, e.g., page 1, lines 25-36) as follows:

"The present inventor has made an investigation on the effective utilization of an extraction residue of roasted coffee beans which is usually dumped. As a result, it has unexpectedly been found that, if an extraction residue of roasted coffee beans is supplemented with a saccharide and fermented with the aid of a yeast for the brewing of alcoholic liquors (e.g., wine yeast), the alcoholic fermentation causes the aroma of coffee to be developed again in spite of the substantial absence of coffee extract in the extraction residue used as the raw material, and an alcoholic drink having a rich aroma of coffee and an excellent taste is obtained."

Entry of the proposed new claims is requested because only the preamble is changed but without introduction of new matter, and without modification of the manipulative steps and because the cancellation of claims 8 and 9 will materially reduce the issues remaining for reconsideration and appeal in the event that the final rejection is not withdrawn.

However, as discussed below, it is submitted that the Final Rejection should be withdrawn and the subject application passed to issue.

In this regard, it is submitted to be quite evident that none of the cited prior art references to Papazian, Rizzi or Suzuki, in any way teach or suggest subjecting an extraction residue of roasted coffee beans to alcoholic fermentation, and especially in the presence of wine yeast. Clearly, none of the references teach or suggest any process or means for re-introducing coffee-flavor from the coffee-flavor depleted extraction residue of roasted coffee beans.

Accordingly, Applicant again respectfully requests that the Examiner reconsider and withdraw the final rejection of claims 1-4 and 8-10 and 12-16, as unpatentably obvious over Papazian in view of Rizzi, et al, and the final rejection of claim 11 over the same references, further in view of Suzuki.

By changing the preamble, it is hoped that the issue will become clearly removed from the differences between beers and wines (although Applicants maintain their position that beers and wines are not the same or overlapping substances) as products and will more clearly focus on the manipulative steps and the concomitant result of "re-production of coffee-flavor from an extraction residue of roasted coffee beans."

Papazian only discloses addition of freshly ground coffee to a particular type of alcoholic beverage (Blue Mountain Stout). There is no disclosure or suggestion of fermenting (with any type of yeast, with or without hops, etc.) an extraction residue of roasted coffee.

Nothing in the disclosures of Rizzi or Suzuki would suggest to the practitioner of ordinary skill in the art of home brewing (the target audience for Papazian) the modification of Papazian's home brew recipes to substitute for the "highest quality coffee" the defatted spent coffee grounds disclosed by Rizzi or the enzyme antifoaming agent of Suzuki (for claim 11).

In this regard, it will be recalled that Rizzi teaches the use of defatted spent coffee grounds to absorb bitter coffee flavors and burnt coffee aromas. The spent coffee is considered to be cheap, unadulterating and tasteless and, therefore, according to Rizzi, useful as an additive for roast coffee grounds, preferably, "low quality coffee or blends containing low quality coffee where bitter flavors and burnt aromas are often undesirably strong." The defatted spent coffee grounds (DFG) additive are spent coffee grounds that contain from zero to about 2% lipids and are extracted, defatted and dried coffee grounds.

While DFG's may be tasteless and inexpensive absorbents, they are not taught to be useful as a source of a coffee beverage, or substitute for coffee beans in a fermentation process.

Therefore, it is respectfully submitted that a person of ordinary skill in the art, seeking to re-produce coffee flavor from an extraction residue of roasted coffee beans, would not have been motivated to substitute for Papazian's "highest quality coffee" the cheap, unadulterating and tasteless DFGs of Rizzi.

Papazian does not disclose "adding a saccharide to an extraction residue of roasted coffee beans" or subsequently, "fermenting the resulting mixture." Therefore, since Rizzi does not supplement either of these features of the present claims and provides no teaching of using DFG's as a raw material for alcohol fermentation, or otherwise suggest the possibility of re-producing or re-developing coffee flavor from an extraction residue of roasted coffee beans, the combination of the disclosures of Papazian and Rizzi would not make the present invention obvious within the meaning of 35 USC 103(a).

Accordingly, for the above reasons, the rejection of claims 1-4, 8-10 and 12-15 is respectfully traversed.

Furthermore, since Suzuki does not supply any of the deficiencies of the Papazian and Rizzo disclosures, this combination of references would not have made the present invention, as defined in claim 11, obvious to the person of ordinary skill in the art.

Moreover, it is respectfully submitted that the practitioner would not have been motivated to add an enzyme to the home brewing recipes of Papazian, but even doing so would not result in the process defined by claim 11.

Accordingly, the rejection of claim 11, under 35 USC 103(a), is respectfully traversed.

Favorable reconsideration and passage of the subject application to issue, with claims 1-4, and 10-15, is earnestly solicited.

Respectfully submitted,


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